



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,996	04/08/2004	Nicholas A. Matiash	29759/ITW14675(1675.004)	9049
23598	7590	11/28/2007		
BOYLE FREDRICKSON S.C. 840 North Plankinton Avenue MILWAUKEE, WI 53203			EXAMINER KERNS, KEVIN P	
			ART UNIT 1793	PAPER NUMBER
			NOTIFICATION DATE 11/28/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

Office Action Summary	Application No. 10/820,996	Applicant(s) MATIASH ET AL.	
	Examiner Kevin P. Kerns	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 19-24, 26 and 27 is/are allowed.
- 6) ☒ Claim(s) 18, 25, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 and 04 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 18, 25, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitation "the respective rims adjacent sides". There is insufficient antecedent basis for this limitation in the claim. In addition, this limitation is indefinite if the term "rims" was not intended to be in its possessive form "rim's".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 25, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaputis (US 4,068,106).

Shaputis discloses a welding apparatus that includes a wire feeder and drive feed roller assembly, in which the drive roller assembly includes one or more contacting and radially aligned drive rolls adapted to feed weld wire 12 having a predetermined diameter, with the drive roll(s) including opposing first and second sides defining a width

Art Unit: 1793

dimension therebetween (Figures 2-4), thus defining drive roll body/bodies between the first and second sides; an outer circumferential body surface in the form of multiple (first, second, and third) circumferentially-extending grooves/channels/recesses (52,74) of angular cross-section corresponding to a diameter of weld wire 12 about a periphery of the drive roll body between the first and second sides; and a plurality of rims (elevated areas above the grooves/channels/recesses (52,74) extending radially outwardly from and along a major circumferential portion of the outer circumferential body surface), with the rims defining generally arcuate profiles at their outermost surfaces 72 and a diameter that is greater than remaining diameters (of the grooves/channels/recesses) measured along the width of the drive roll bodies, such that the rims and adjacent channels share (touch) a common sidewall segment while defining a clearance between remaining aligned portions (abstract; column 1, lines 51-68; column 2, lines 1-32 and 54-68; column 3, line 1 through column 4, line 47; and Figures 2-5).

Allowable Subject Matter

5. Claims 1-16, 19-24, 26, and 27 are allowed.

Response to Arguments

6. The examiner acknowledges the applicants' amendment received by the USPTO on November 2, 2007. The amendments overcome prior claim objections. However, new 35 USC 112, 2nd paragraph rejections have been raised by the amendments to

Art Unit: 1793

independent claim 18 (see above section 2). Allowable subject matter is presented in above section 5. The applicants have cancelled claims 31-36 and 38-40. Claims 1-16 and 18-29 are currently under consideration in the application.

7. Applicants' arguments filed November 2, 2007 have been fully considered but they are not persuasive.

With regard to the applicants' remarks/arguments on pages 9 and 10 of the amendment (addressing rejections of claims 18, 25, 28, and 29 in above section 4), it is noted that the drive rollers of Shaputis include rims and channels that share a common sidewall segment, as well as the newly added limitation of independent claim 18 (see newly underlined portion in above section 3). Namely, the limitation "a clearance is defined between remaining aligned portions" would be present, as the term "clearance" is subject to broad interpretation as any "space" between two surfaces, whether or not the surfaces are abutted. During patent examination, the pending claims must be "given the broadest reasonable interpretation.". Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In the instant case, the broadest reasonable interpretation of the term "clearance" would apply to any "space" between two surfaces, even abutting surfaces. As a result, claims 18, 25, 28, and 29 remain rejected.

Art Unit: 1793

Conclusion

8. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jonathan Johnson can be reached on (571) 272-1177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kevin P. Kerns *Kevin Kerns* 11/21/07
Primary Examiner
Art Unit 1793

KPK

kpk

November 21, 2007